

REMARKS

Claim 1 has been amended by incorporating the subject matter of claim 12 into it, thereby requiring the oily phase to be polar (meeting specified Hansen solubility characteristics).

Claim 28 has been amended to require a ΔE value of at least 5 after irradiation with UV for 2 minutes. Support for this amendment exists, *inter alia*, in example 7 of the present application.

Claims 12, 14, 15 and 18-25 have been canceled.

New claims 33-42 directed to specific polar oils, specific concentrations of polar oils and/or specific Hansen solubility characteristics have been added. Support for these new claims exists throughout the present application including pages 32 and 63.

New claim 43 is directed to specific ΔE values resulting from the combination of specific polar oils and specific photochromic dyes. Support for this new claim exists throughout the present application including example 6.

Claims 1-11, 13, 16, 17 and 26-43 are currently pending, although claim 31 has been withdrawn from consideration. Upon indication of allowable subject matter, Applicants intend to seek appropriate rejoinder of withdrawn claim 31 pursuant to MPEP 821.04.

The Office Action rejected claims 1, 3-17, 26-30 and 32 under 35 U.S.C. §103 as obvious over U.S. patent 6,123,952 (“Lagrange”) in view of PCT patent application publication no. WO 99/31081 (“Clark”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The claimed invention relates to compositions containing at least one photochromic organic dye of specified structure and a polar oily phase having specified Hansen solubility characteristics. The combination of such an organic dye and such an oily phase results in a unique solvatochromic effect. That is, the combination of the required dye with the required oily phase results in a greater color change (represented by ΔE) as compared to other solvents/dyes.

This unique effect is demonstrated in example 6 of the present application, in which an organic dye of the present invention was mixed with various oils of various polarities, and the ΔE resulting from addition of the dye to the oil was determined. As can be seen in example 6, the more polar the oil, the greater the ΔE . This effect remains after exposure to UV light (example 7) and in the presence of a structured composition (example 8). This combination also leads to unique compositions which, upon exposure to UV sunlight, quickly and reversibly change colors. (See, example 12). None of the applied art teaches or suggests the claimed compositions, or any of the beneficial properties discussed above associated with such compositions.

Lagrange states that his compositions contain only thermally irreversible photochromic compounds which are diarylethene derivatives, not naphthopyran compounds. Thus, Lagrange discloses very structurally different dye compounds. For at least this reason, Lagrange cannot teach or suggest the claimed composition.

Clark neither teaches nor suggests dissolving the required dye in the required oily phase having the necessary Hansen solubility characteristics, or any of the benefits associated with combining the required dyes with the required polar oily phase. Rather, Clark teaches

away from such dissolution, stating that his dyes are incorporated into polymeric materials, (see, page 5, 2nd and 3rd paragraphs), so Clark cannot teach or suggest the claimed dissolution of the required dyes in the required polar oils, or any benefits associated from such combinations.

Furthermore, as discussed above, the specified combination of polar oils and dyes results in significant color properties of cosmetic compositions thus formed, results which are neither taught nor suggested by the applied art. The applied art would not have led one skilled in the art to prepare the claimed compositions with the reasonable expectation that significant color properties would result, particularly given the express teaching in Clark that pH change is necessary for his dyes to function according to his disclosure.

This is particularly true given that neither Lagrange nor Clark recognizes oil polarity values (Hansen solubility characteristics) as being a result effective variable. A “result effective variable” is “a variable which achieves a recognized result.” See, MPEP § 2144.05 II. B. Optimizing such a variable presupposes that optimization of the recognized result occurs. Because neither Lagrange nor Clark recognizes oil polarity values (Hansen solubility characteristics) as being a result effective variable, no motivation would have existed to optimize such polarity, meaning that the applied art would not have suggested to one skilled in the art to select the required oily phase having the required Hansen solubility characteristics.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection.

Moreover, Clark and Lagrange are not properly combinable. Clark's dyes are pH sensitive, and change color upon change in pH. In contrast, Lagrange's compositions are pH static -- they do not change pH. One skilled in the art, seeking to use Clark's pH-sensitive dyes, would not seek to place them in a pH-static environment like Lagrange's compositions where they would be unable to fulfill their purpose (changing color upon pH change). To make such a substitution would render Clark's dyes unsuitable for their intended purpose. See MPEP § 2143.01. Thus, rather than suggest the claimed invention, these references actually teach away from it. Under such circumstances, Clark and Lagrange are not properly combinable, and cannot form the basis for a rejection under 35 U.S.C. §103.

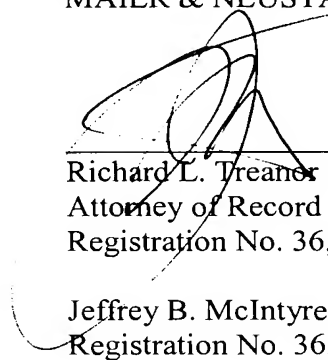
For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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